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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-----------------|----------------------|------------------------|------------------|
| 09/449,002 | 11/24/1999 | JOHN P. FALLON | 1166/58111 | 5698 |
| 75 | 7590 07/21/2006 | | EXAMINER | |
| RICHARD F. JAWORSKI | | | SMITH, RUTH S | |
| IVAN S. KAVI | | | ART UNIT | PAPER NUMBER |
| COOPER & DUNHAM L.L.P. 1185 AVENUE OF THE AMERICAS 23RD FLOOR 3737 | | | | |
| NEW YORK, | NY 11036 | | DATE MAILED: 07/21/200 | 6 |

Please find below and/or attached an Office communication concerning this application or proceeding.

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| | Application No. | Applicant(s) | | | | |
| | 09/449,002 | FALLON ET AL. | | | | |
| Office Action Summary | Examiner | Art Unit | | | | |
| | Ruth S. Smith | 3737 | | | | |
| The MAILING DATE of this communication a Period for Reply | ppears on the cover sheet w | ith the correspondence address | | | | |
| A SHORTENED STATUTORY PERIOD FOR REP WHICHEVER IS LONGER, FROM THE MAILING - Extensions of time may be available under the provisions of 37 CFR after SIX (6) MONTHS from the mailing date of this communication If NO period for reply is specified above, the maximum statutory perio - Failure to reply within the set or extended period for reply will, by state Any reply received by the Office later than three months after the mail earned patent term adjustment. See 37 CFR 1.704(b). | DATE OF THIS COMMUN 1.136(a). In no event, however, may a nd will apply and will expire SIX (6) MO ute, cause the application to become A | CATION. reply be timely filed NTHS from the mailing date of this communic BANDONED (35 U.S.C. § 133). | | | | |
| Status | | | | | | |
| 1) ⊠ Responsive to communication(s) filed on 12 2a) ☐ This action is FINAL. 2b) ⊠ Th 3) ☐ Since this application is in condition for allow closed in accordance with the practice under | nis action is non-final. vance except for formal ma | • | ts is | | | |
| Disposition of Claims | ` | | | | | |
| 4) ☐ Claim(s) 1,2,4-15 and 17-27 is/are pending in 4a) Of the above claim(s) is/are withdrest 5) ☐ Claim(s) 23-27 is/are allowed. 6) ☐ Claim(s) 1,2,4-15 and 17-22 is/are rejected. 7) ☐ Claim(s) is/are objected to. 8) ☐ Claim(s) are subject to restriction and Application Papers | rawn from consideration. | | | | | |
| 9) The specification is objected to by the Examin | ner | | | | | |
| 10) The drawing(s) filed on is/are: a) accepted or b) objected to by the Examiner. | | | | | | |
| Applicant may not request that any objection to the | ne drawing(s) be held in abeya | nce. See 37 CFR 1.85(a). | | | | |
| Replacement drawing sheet(s) including the correct 11) The oath or declaration is objected to by the | | | | | | |
| Priority under 35 U.S.C. § 119 | | | | | | |
| 12) Acknowledgment is made of a claim for foreign a) All b) Some * c) None of: 1. Certified copies of the priority docume 2. Certified copies of the priority docume 3. Copies of the certified copies of the priority docume application from the International Bure * See the attached detailed Office action for a limit | ents have been received. Ints have been received in a circling documents have bee eau (PCT Rule 17.2(a)). | Application No n received in this National Stage | е | | | |
| Attachment(s) 1) Notice of References Cited (PTO-892) | 4) ☐ Interview | Summary (PTO-413) | | | | |
| Notice of Draftsperson's Patent Drawing Review (PTO-948) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/0 Paper No(s)/Mail Date | Paper No | (s)/Mail Date Informal Patent Application (PTO-152) | | | | |

Application/Control Number: 09/449,002

Art Unit: 3737

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 18-22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are directed to merely generating a file containing data and therefore provide any tangible results.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1,2,4-15,17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Finger or Mortimore et al. Mortimore et al discloses a method for generating a DICOM compatible file where the quantitative data is considered to be placed in a field other than an image field. It should be noted that applicant states that DICOM is the standard used in the industry to communicate medical files in electronic form. Mortimore et al disclose the use of a DICOM compatible file, see column 3, line 52, column 4, lines 39-41, column 5, line 28. Finger discloses a method for generating a DICOM compatible file where the quantitative data is considered to be placed in a field other than an image field. It should be noted that applicant states that DICOM is the standard used in the industry to communicate medical files in electronic form. Finger discloses the use of a DICOM compatible file, see column 22, lines 47-50. The use of a bone densitometer to provide a bone scan and its related data is old and well known, as disclosed by applicant. It would have been obvious to one skilled in the art to have modified Finger or Mortimore such that the image data provided is provided by a bone densitometer and the quantitative data being related to the bone scan. Such a modification merely involves the substitution of one known type of scan for another.

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Response to Arguments

Applicant's arguments filed June 27, 2005 have been fully considered but they are not persuasive. Applicant's remarks are noted, however, the rejection of claims 1-17 stands in view of the teachings of Mortimore et al and Finger which each discloses the use of a DICOM compatible file as discussed above. Applicant's remarks are not fully understood and the claims still appear to read on the prior art of record.

Allowable Subject Matter

Claims 23-27 are allowable over the prior art of record.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ruth S. Smith whose telephone number is 571-272-4745. The examiner can normally be reached on M-F 7:30 AM-4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on 571-272-4956. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1090.

Ruth S. Smith Primary Examiner Art Unit 3737